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Dated: December 14, 2007

Signature: Anthony Matson

(Anthony Matson)

Patent

Docket No. 532212000624



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER MPEP § 724.02

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the documents listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to these documents because they are **SUBJECT TO PROTECTIVE ORDER** or **PROPRIETARY** information. It is respectfully requested that the Examiner consider the information during the prosecution of this application.

The document numbers 1-84 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is

enclosed in a sealed, clearly labeled envelope. Document numbers 1-75 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), appealed at the United States Court of Appeals for the Federal Circuit as case numbers 06-1087 and 06-1443. Document numbers 76-84 are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx). Scantibodies Laboratory, Inc. is the assignee of the present application.

Document number 85 listed on the attached Form PTO/SB/08a/b is **PROPRIETARY** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of the **PROPRIETARY** document listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

Pursuant to MPEP § 2004.13, Applicants point out the following:

- Exhibit M of document No. 3, “Claim Chart for U.S. Patent No. 6,030,790” submitted by Nichols, in which United States Patent number 6,689,566 (the ‘566 patent) is discussed. The present application is a Continuation of United States Patent number 6,743,590, which is a Continuation-in-Part of the ‘566 patent.
- Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D. (Document No. 13 in the present Form PTO/SB/08a/b), in which prosecution of the ‘566 patent is discussed.
- April 7, 2005 Declaration of Thomas L. Cantor (with the attached Exhibit A, Facsimile from Dr. Gao to Dr. Kao on September 21, 1998 and the attached Invoice Form) (Document No. 85 in the present Form PTO/SB/08a/b) in connection with U.S. Patent Application No. 10/617,489. In the declaration, a shipment of three PTH (1-84) Specific IRMA Kits on September 21, 1998 from Dr. Ping Gao, a named inventor of the ‘566 patent, to Dr. Pai C. Kao of the Mayo Clinic is disclosed.

- Deposition of Thomas Cantor, taken on August 27, 2003 (Document No. 51 in the present Form PTO/SB/08a/b) in which Mr. Cantor answered questions about the use of PTH (1-9) peptide (*See e.g.*, Document No. 51 at pages 78-80.)
- Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 76 in the present Form PTO/SB/08a/b) may contain information potentially relevant to the Declaration of Thomas L. Cantor (Document No. 85 in the present Form PTO/SB/08a/b).
- At page 00245, lines 12-13 of the Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 76 in the present Form PTO/SB/08a/b), the sales figure of “Immutopics BioActive PTH ELISA assays” is redacted.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.

- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
- ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)


Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000624.

Dated: December 14, 2007

Respectfully submitted,

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